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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/029,313

12/28/2001

Dino M. Morson

D/A0865

3485

7590

07/19/2004

Patent Documentation Center

Xerox Corporation

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EXAMINER

ASHLEY, BOYER DOLINGER

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 07/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/029,313

Applicant(s)

MORSON, DINO M.

Examiner

Boyer D. Ashley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 and 10-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-4, 8, 9 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. This office action is in response to applicant's amendment filed 5/5/04, wherein claim 30 was added. It should be noted that applicant's amendment incorrectly labeled claims 28 and 29 as new. Claims 5-7 and 10-29 remain withdrawn from consideration.

Specification

2. The abstract of the disclosure is objected to because it contains legal phraseology, e.g., "comprises". This language was inadvertently missed in the previous office action. Any inconvenience is regretted. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102 & 103

3. The text of those sections of Title 35, U.S. Code 102 & 103 not included in this action can be found in a prior Office action.

4. Claims 1-4, and 8-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Holzhauser et al., U.S. Patent 6,295,908, as set forth in paragraph 8 of paper number 8.

5. Claims 1-4 and 8-9 are rejected under 35 U.S.C. 102(e) as anticipated by Japanese application 2000-169890, hereinafter JP '890, or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP '890 in view of Holzhauser, as set forth in paragraph 9 of paper number 8.

6. Claims 1-4, 8-9, and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Ueda et al., U.S. patent 6,672,504.

Ueda et al. discloses the same invention as claimed including:

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Ueda et al. discloses the same invention as claimed including, for example, a hole punch apparatus for perforating sheets in a sheet path comprising: a member rotatable (559) in the direction the sheet path; a first punch (541B) attached to the member and positioned to intersect the sheet path when rotated to a position orthogonal to the sheet path (see Figures 15-23); a second punch (541A) attached to the member, the second punch positioned to intersect the sheet path when rotated to a position orthogonal to the sheet path and positioned at an angle relative to the first punch (see Figures 1 and 2) such that when either the first or second punch intersects the sheet path, the other punch is rotated to a position that does not intersect the sheet path; a drive mechanism (551-554) for powering the rotation of the member; and a controller (301) cooperating with the drive mechanism and capable of controlling the rotation of the member such that when one punch is selected for intersection with a sheet in the sheet path, the rotation is timed such that the other punch intersects the sheet path in a space between pitches (see column 14, lines 60-67; column 15, lines 43-54).

As to claim 2, the first punch includes multiple punches (see Figures 15-23).

As to claim 3, the second punch includes multiple punches (see Figure 15-23).

As to claim 4, there are two first punches and three-second punches (see Figure 23).

As to claim 8, the first and second punches are oriented 180 degrees from each other.

As to claim 9, a third punch (one of the punches 24) is included in the device (see Figure 1).

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As to claim 30, Ueda et al. includes first and second punches that are diametrically opposed on the rotating member (see Figure 21).

Response to Arguments

7. Applicant's arguments filed 5/5/04 have been fully considered but they are not persuasive.

Applicant, again, traverses the restriction requirement as unreasonable and not based on a requirement to perform multiple searches. However, the examiner respectfully disagrees. As stated in the restriction requirement each of the specified groups require additional searches. For example, group II is specific to the paper path that not only requires a search in class 83/438 but also in the image forming art of 101, 270, or 399; conversely, Group I does not require that search. Group III requires a search for specific sensors that require searching 83/365 as well as 83/72; conversely, Group I does not require that search. Group IV requires a search for specific sensors that require searching 83/13; conversely, Group I does not require that search. Claims 26-27 and 28-29 are directed to a marking apparatus in combination with a hole-punching device which is properly classed in class 399 or 270 as evident by U.S. Patent 6,381,443. Class 83 is a basic cutting class and does not take any combinations. Applicant is directed to United States Patent and Trademark web page for a complete list of the class definitions. The Examiner may be willing to rejoin these claim if 1) no additional structure is added to the claims regarding the image formed mechanisms and guide paths; and 2) allowable subject is discovered for the generic claim 1 directed a

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hole punch and is incorporated in to claim 26. However, the examiner will not be willing to do it after final, as the examiner would have to search classes 399, 270 and 101.

Applicant contends that Holzhauser et al. lacks the limitation, "rotation is timed such that the other punch intersects that sheet path in a space between pitches", because the rotating punches of Holzhauser et al. are controlled to cease rotating of the shafts to prevent the second punches from engaging the sheet medium. Although, the examiner does agree with applicant interpretation of the Holzhauser et al. reference he does not agree with applicant's own interpretation of claim 1. All that is required by claim 1 is that the rotation be timed such that opposing punches intersects the sheet path in between fed sheets. Nothing in claim 1 requires continuous rotation or continuous sheet feeding. The rotation of the Holzhauser et al. device is controlled and timed such that the opposing punches do not intersect any medium and is between pitches because after the rotation is ceased, to allow the sheet medium to continue traveling unobstructed, rotation is again started forwardly or reversely to their original positions. If the rotation is forwardly then the second punches will intersect the sheet path in between pitches because it must rotate through the intersection so that the punching unit is in the original position.

Applicant contends that JP '890 teaches away from the instant invention because it teaches that the punches and dies are returned to the waiting position after detecting a paper end by a paper end detecting means. However, it should be noted that claim 1 is not limited to any specific interpretation, that is, nothing in claim 1 suggests that the rotating punching unit cannot be returned to the waiting position after each punching

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operation. Therefore, it is irrelevant whether JP '890 purportedly teaches away from the intended use of instant disclosure.

8. For the reasons above, the grounds of rejection are deemed proper.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

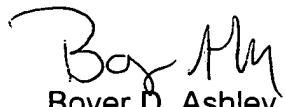
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer D. Ashley whose telephone number is 703-308-1845. The examiner can normally be reached on Monday-Thursday 7:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Boyer D. Ashley
Primary Examiner
Art Unit 3724

BDA
7/15/2004